

REMARKS/ARGUMENTS

This reissue application was filed on February 4, 1999 to correct errors in United State Patent No. 5,769,688 ("the 688 patent") which issued on June 23, 1998.

Consideration of this Amendment After Final Rejection is respectfully requested.

The Reissue Claims

Claims 11-22 are presented in this reissue application. Independent Claim 11 and Claims 12-16 dependent therefrom are directed to a chest and breast protector having a hard breast plate forming a left cup and a right cup, emphasizing a flexible center sternum area and having straps attached to each cup. Independent Claim 17 and Claims 18-22 dependent therefrom are directed to a chest and breast protector having a hard breast plate and emphasizing a flexible center sternum area and having means to apply pressure to the left cup and the right cup of the protector.

The Sole Rejection

The sole rejection in this reissue application is that Claims 11-22 are rejected under 35 U.S.C. §251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based.

The Applicant will show through the facts discussed below that there has been no improper "recapture".

The Law Relating to Recapture

The recapture rule "prevents a patentee from regaining through reissue the subject matter that he surrendered in an effort to obtain allowance of the original claims." *Pannu v. Storz Instruments, Inc.*, 258 F.3d 1366, 1370-1371 (Fed. Cir. 2001) quoting *In re Clement*, 131 F.3d 1464, 1468 (Fed. Cir. 1997). Under this rule, reissued claims that are broader than the original patent's claims in a manner directly pertinent to the subject matter surrendered during prosecution are impermissible. *Pannu*, 258 F.3d at 1371.

Both the courts and the Patent Office have applied a three-step process to the "recapture rule". *Pannu*, 258 F.3d at 1371 and MPEP §1412.02(l).

The first step is to "determine whether and in what 'aspect' the reissue claims are broader than the patent claims." *Clement*, 131 F.3d at 1468.

“The second step is to determine whether the broader aspects of the reissued claim related to surrendered subject matter.” *Clement*, 131 F.3d at 1468.

Third, “the court must determine whether the reissued claims were materially narrowed in other respects to avoid the recapture rule.” *Clement*, 131 F.3d at 1468.

The Procedural Facts

(1) The Original Claims

The ‘688 patent issued with independent Claim 1 and three dependent claims. Claims 1 and 3 of the ‘688 patent read as follows:

1. A chest and breast protector for women athletes, comprising in combination:
 - a. a hard internal breast plate formed to provide a right and left cup of equal size conforming to the contour of a woman’s breasts, said hard internal breast plate conforming to the contour of a woman’s breasts and front torso;
 - b. a soft rubberized foam exterior and interior surrounding the entirety of said hard internal breast plate;
 - c. a center sternum area connecting said right and left cups; and
 - d. a sternum hinge member having flexibility along a longitudinal axis passing between said right and left cup.

3. The chest and breast protector as claimed in claim 2 wherein said chest and breast protector further comprises:
 - a. a right and left bottom lip extending just below the right and left breast providing vertical support to the breasts and protection to the ribs just below the breasts; and
 - b. a strapping means to firmly secure the breasts within said chest and breast protector against the chest area of a woman whereby the breasts and surrounding connective tissues are protected from adverse effects of acceleration and deceleration movements.

As shown, in Claim 1, the element “means for flexing” has been a part of the claims since the application for the ‘688 patent was filed. In a like manner, the element claiming the “soft rubberized foam exterior and interior surrounding the hard internal breast plate” has also been a part of the claims since the application for the ‘688 patent was filed.

The specification notes that a specific object of the invention is to provide a breast and chest protector having sufficient protection in the sternum area while still providing flexibility for movement. *Col. 2, lines 31-34.*

In other words, from the get go *one* novel aspect of the invention has been the provision of a flexible area between the cups.

(2) The Office Action

In the first and only Office Action, Claim 5, directed to the use of hinges to provide flexibility between the cups, was objected to but allowability was indicated if the claim were rewritten in independent form. ***[This clearly indicates that the Examiner considered patentability to reside in the flexible area between the cups.]*** The only rejection over art was that “Claims 14 and 6-8 were rejected under 35 U.S.C. §103 as being unpatentable over Martin *et al.* (UK Patent Appl’n 2 069 318 A) in view of Barnes (3,176,686).”

The Examiner, speaking of the disclosure in Martin *et al.* said that

“Martin *et al.* discloses a chest and breast protector for women’s athletes. The protector comprises a hard internal breast plate formed to provide a right and left cup of equal size conforming to the contour of a woman’s breasts and including a center sternum area. Martin *et al.* disclose that the plastic front piece is semi-rigid and very resistant to deformation, thus fulfilling the hardness limitation; He also states that to avoid chafing a foam material may be employed. . . . However, Martin *et al.* lacks the flexing means along a longitudinal axis passing through the center sternum area.” *Office Action at pp. 2-3.*

Regarding Barnes, the Examiner held that Barnes disclosed a breast protector having a semi-rigid or hard internal plastic material covered by a resilient shock absorbing material and that Barnes disclosed a “flexing means along a longitudinal axis passing through the sternum area.”

The Examiner concluded that it was “obvious to one of ordinary skill in the art to modify the protector of Martin et al. by including a resilient shock absorbing cover as taught by Barnes and the flexing means in the sternum area in order to prevent the hard plastic from digging into the skin upon being impacted upon by a force.”

(3) The Applicant's Response

The Applicant responded to the Office Action by way of amendment to Claims 1 and 5 and providing arguments as to why the prior art did not make the Claim 1 obvious.

First, Claim 1 amended to provide a minor modification of the soft rubber foam exterior and interior and change the language regarding the “means for flexing” with more specific language wherein the “means for flexing” was narrowed to a hinge member”, as shown;

e. a sternum hinge member having flexibility along a longitudinal axis passing between said right and left cup.

The applicant's attorney argued that Barnes' disclosure of a pocket for the reception of the lower end of the cup was not a disclosure of a uniform soft rubber foam exterior covering the complete interior of the hard internal breast plate. Regarding Martin *et al.*, it was argued that the padding did not act to absorb shock, instead it was a means to avoid chaffing. The applicant's attorney added that Martin *et al.* did not disclose a well defined cup shape integral to a rigid, hinged protective chest plate.

There was no need for the applicant's attorney to argue the elements providing flexible movement between the cups because the Examiner had already indicated this feature made the claims allowable.

In response, the claims were allowed, without any reasons for the allowance. Therefore, it must be assumed that the applicant's attorney's arguments about the “hinge member” provided the reason for patentability since both Martin *et al.* and Barnes disclosed a foam covering surrounding the cups.

(4) The Reissue Claims

The reissue claims were initially rejected. The applicant's attorney responded on March 5, 2001 and March 14, 2002 addressing the reissue oath, amending the claims to the present form and providing arguments distinguishing Martin *et al.* the present

Office Action, dated some 4 years later withdrew the prior art rejection and is limited to the recapture rejection.

The Examiner's Position

The Examiner alleges:

A broadening aspect is present in the reissue which was not present in the application fro [sic] patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 USC 251, and the filing of the present reissue. *Office Action at page 2.*

The examiner, in applying the three step test for recapture states:

In this case, applicant argued in the parent application 08/617,507, paper 3A, page 4 under 35 USC 103 that none of the references disclose a uniform soft rubberized foam interior, as disclosed and claimed. Henceforth, this limitation included in claim 1 of the Patent was critical and depended upon for allowance of the claim over the prior art. *Office Action at pages 2-3.*

Regarding the second step, the examiner states:

The reliance by applicant to define the original patent claims over the art can be by way of presentation of new/amended claims to define over the art, or an argument/statement by applicant that a limitation of the claim(s) defines over the art. Applicant's arguments effective constitute surrender of the claimed subject matter that cannot be captured via reissue. *Office Action at p. 3.*

The Examiner simply concluded that

This claim [referring to Claim 11] appears to be broader in scope than those claims canceled in the original application. Accordingly claims 11-22 must include therein the same uniform soft rubberized foam interior limitation as that of claim 1 because it was relied upon, in arguments by the applicant, for patentability over the prior art of record. *Office Action at pp. 3-4.*

The Issue at Hand

Does the deletion in proposed reissue Claims 11 and 17 of element - the soft rubberized foam exterior and interior, etc. - from Claim 1 of the '688 patent constitute an improper broadening recapture under 35 U.S.C. §251? No.

Arguments as to Why There Is No Recapture

(1) The First Step Analysis

The first step in the analysis is to “determine whether and in what ‘aspect’ the reissue claims are broader than the patent claims.”

First off, it should be remembered that this is a broadened application for reissue. Thus it is without debate that the reissue claims are broader than the patent claims.

Second, the aspect in which the reissue claims are broadened is that element (b) - a soft rubberized foam exterior and interior surrounding the entirety of said hard internal breast plate - was deleted.

(2) The Second Step Analysis

The second step is to determine whether the broader aspects of the reissued claim related to surrendered subject matter.

The novelty of the claims was indicated by the Examiner in the very first Office Action, i.e., the provision of flexible movement between the cups reflected in element (d). Although the applicant revised language of element (d) somewhat the essence of the language is and has always been present. As shown by the facts discussed above, the applicant did not surrender subject matter directly pertinent to the allowance of the original claims.

Although it is unquestioned that applicant's attorney argued against the combination of Martin *et al.* and Barnes as teaching a soft rubberized foam exterior, it is clear, as shown above, that the reason for allowance was the flexible area between the cups. Unfortunately, no reasons for the allowance were provided by the Examiner, but it would stand to reason that the initial reason for the allowance was the flexible area between the cups. This is so because both Martin *et al.* and Barnes had a rubberized

Appl. No.09/244,374
Amendment Dated September 21, 2006
Reply to Office Action of July 18, 2006

foam exterior and interior; whereas Martin *et al.* did not have any disclosure of a flexible area.

(3) The Third Step Analysis

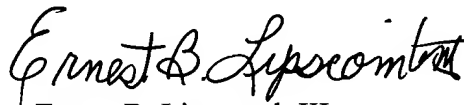
In the third step of the analysis the court must determine whether the reissued claims were materially narrowed in other respects to avoid the recapture rule."

Although there was no third step analysis, it should be noted that the applicant added the strap limitations to independent claims 11 and 17, thereby significantly narrowing the claims and thus avoiding the recapture rule.

Having shown that there was no recapture under section 251, the applicant submits that the rejection based on a defective oath is now moot.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper.

Respectfully submitted,



Ernest B. Lipscomb III
Registration No. 24,733

Barnwell Whaley Patterson & Helms
P.O. Drawer H
Charleston, SC 29402
Tel: (843) 577-7700
Fax: (843) 577-7708

Appl. No.09/244,374
Amendment Dated September 21, 2006
Reply to Office Action of July 18, 2006

CERTIFICATE OF MAILING

I hereby certify that this Response to Final Office Action Dated July 18, 2006, is being deposited with the United States Postal Service with sufficient postage for first class mail addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on this 21st day of September 2006.



Lisa Benson
Legal Assistant to B. CRAIG KILLOUGH
and ERNEST B. LIPSCOMB, III
Attorneys for Applicant
P.O. Drawer
Charleston, SC 29402
(843) 577-7700